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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,004	11/28/2001	Christopher A. Julian	017516-002580US	3890
7590 06/08/2005			EXAMINER	
PATENT DEPT INTUITIVE SURGICAL, INC 950 KIFER ROAD SUNNYVALE, CA 94086			JACKSON, GARY	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 09/998,004	Applicant(s) JULIAN ET AL.	
	Examiner Gary Jackson	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-17,19-30,33-44,47-53,55-60,75,76,78,80-87 and 103-154 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-16,43,44,47-52,75,76,78,80-87 and 117-150 is/are allowed.
- 6) ☒ Claim(s) 17,19-30,33-40,53,55-58,103-105,107-109,112-116 and 151-154 is/are rejected.
- 7) ☒ Claim(s) 11,41,42,59,60,106 and 110 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This action is responsive to applicants' amendment filed March 10, 2005. The amendment and arguments have been considered, however, it does not place the application in condition for allowance. A new ground of rejection is set forth below.

The indicated allowability of the claims is withdrawn in view of the newly discovered reference(s) to Vierra et al (US Patent 5,807,243). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 151 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Vierra et al (US Patent 5,807,243). See column 3, next to last paragraph and column 4.

Claims 151 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hossain et al (US Patent 6,063,021). See column 2 and column 6, lines 4-6.

Claims 103 is rejected under 35 U.S.C. 102(b) as being unpatentable over Fox et al in (US Patent 5,865,730).

Claim Rejections - 35 USC § 103

Claims 17, 19, 20-30, 33-40, 53, 55-58, 103-105, 107-109, 112-116, 151-154 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al (US Patent 5,865,730) in view Vierra et al (US Patent 5,807,243). Substantially each of the limitations in the above claims, however, Fox does not explicitly indicate that the foot is

insertable into an endoscope. However, the patent to Vierra et al suggests manipulating a foot member of a stabilizing device for insertion into an endoscope. It would have been obvious to one having ordinary skill in the art to modify Fox et al as taught by Vierra et al so that the foot can be inserted into an endoscope. See column, lines 32-49; column 4, lines 9-26 and column 7, lines 39-40.

Response to Arguments

Applicant's arguments, filed March 10, 2005, with respect to the rejection(s) of claim(s) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Vierra et al and Fox (US Patent 5,865,730).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Jackson whose telephone number is (571) 272-4697. The examiner can normally be reached on Mon.-Thurs. 7:30 am to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Antoine Nguyen can be reached on (571) 272-4693. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary Jackson
Primary Examiner
Art Unit 3731

A handwritten signature in cursive script, appearing to read "Gary Jackson", written in black ink.

gj
June 6, 2005